

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROGER A. FRENCH
and
EZRA T. PEACHEY

Appeal No. 2002-1316
Application No. 09/049,036

ORDER REMANDING TO EXAMINER

On page 3 of the Examiner's Answer mailed March 8, 2001
(Paper No. 15), the examiner listed the following references
under the heading "(9) Prior Art of Record";

5045635	Kaplo et al	9, 1991
5202536	Buonnano	4, 1993
3889043	Jean Ducros	6, 1975
5826638	Jelic	10, 1998
5351812	Eagon	10, 1994
5309680	Kiel	5, 1994
411552 [sic, 4110552]	Lombardi	8, 1978

However, the above references do not appear in the discussion
of the "Grounds of Rejection." It is noted that the Harada

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(5,160,806), Hartwell (3,026,367) and Rostek (no number given) references cited on pages 3-9 of the Examiner's Answer under the headings "(10) Grounds of Rejection" and "(11) Response to Argument" are not included as "Prior Art of Record." In accordance with § 1211 of the Manual of Patent Examining Procedure (MPEP) (7th Ed., Rev. 1, Feb. 2000), clarification is required regarding the pertinence of the Harada, Hartwell and Rostek references. In addition, MPEP § 1208(A)(9) states:

(A) REQUIREMENTS FOR EXAMINER'S ANSWER.
The examiner's answer is required to include, under appropriate headings, in the order indicated, the following items:

. . .

(9) References of Record. A listing of the references of record relied on, and, in the case of nonpatent references, the relevant page or pages.

If appropriate, compliance with MPEP § 1208(A)(9) is required in listing the Harada, Hartwell and Rostek references under the heading "Prior Art of Record" appearing in the Examiner's Answer mailed March 8, 2001 (Paper No. 15).

In addition, appellants submitted a paper entitled "Request for Reconsideration" on August 3, 2000 (Paper No. 11).

Page 1 stated:

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[P]lease make the following amendment to
reduce the issues in this application:

IN THE CLAIMS:

Cancel claim 18.

The examiner indicated on this paper by handwritten note "Please Do not enter!" along with his initials. However, the Advisory Action mailed August 25, 2000 (Paper No. 12) stated that "[t]he proposed amendment will be entered upon filing of a Notice of Appeal and an Appeal Brief" and "[f]or purposes of Appeal, the status of the claims is as follows (see attached written explanation, if any): Claims rejected: 1-18." A review of the record indicates that the amendment was not entered. Clarification is required regarding the status of claim 18.¹

Accordingly, it is

ORDERED that the application is remanded to the
examiner:

¹If claim 18 is determined to be pending and still on appeal, the Appeal Brief does not comply with 37 CFR § 1.192(c)(9) (2000) and § 1206(9) of the MPEP which states that the brief shall contain "[a]n appendix containing a copy of the claims involved in the appeal." The appendix is deficient in that it does not contain a copy of claim 18. The Appeal Brief would also not comply with 37 CFR § 1.192(c)(3) "Status of Claims"; (c)(4) "Status of Amendments"; (c)(6) "Issues"; and (c)(7) "Grouping of claims." Appropriate correction would be required.

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1. for clarification under MPEP § 1211 regarding the pertinence of the Harada, Hartwell and Rostek references listed on pages 3-9 of the Examiner's Answer mailed March 8, 2001 (Paper No. 15);

2. if appropriate, for compliance with MPEP § 1208(A)(9) by listing the Harada, Hartwell and Rostek references in a Supplemental Examiner's Answer under the heading "References of Record";

3. for clarification regarding the status of claim 18;

4. if appropriate (i.e., if claim 18 is pending and on appeal), for appellants to submit a new Appeal Brief which contains an accurate statement of the "Status of Claims," "Status of Amendments," "Issues," "Grouping of Claims" and "Appendix" to the Appeal Brief filed January 3, 2001 (Paper No. 14), or for the examiner to issue a supplemental Examiner's Answer which contains a correct statement regarding the above categories; and

5. for such further action as may be appropriate.

It is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting the

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status of the appeal (i.e., abandonment, issue, reopening
prosecution).

BOARD OF PATENT APPEALS
AND INTERFERENCES

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